

Notice of Allowability**Application No.**

09/976,674

Applicant(s)

OI ET AL.

Examiner

Malgorzata A. Walicka

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to July 20, 2004.
2. ☒ The allowed claim(s) is/are 22-31,36 and 40-44.
3. ☒ The drawings filed on 12 October 2001 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

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The Amendment on July 20, 2004 is acknowledged. Claims 1-21 and 39 were previously cancelled. Claims 32-34 have been cancelled by the current amendment. Claims 22, 24, 25, 26, 29, 37, 38 and 41 are amended. Claims 22-31, 35-38 and 40-44 and 40-44 are pending and are the subject of this Office Action.

Detailed Office Action

1. Objections

1.2. Claims

Objections to claim claims 29 and 41 are withdrawn because the claims have been amended.

2. Rejections

2.1. 35 U.S.C. 112, second paragraph

Rejections withdrawn

Rejection of claims 22 under 35 U.S.C. 112, second paragraph, made in the Office Action of June 9, 2004 is withdrawn because the claims have been amended.

Rejection of claims 24 and 25 made in the Office Action of June 9, 2004 is withdrawn because the claims have been amended.

2.2. 35 USC section 112, first paragraph

2.2.1. Lack of written description

Rejections withdrawn

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Rejection of claim 25 and 37 under 35 U.S.C. 112, first paragraph, made in the Office Action of June 9, 2004 is withdrawn, because the claims have been amended as requested.

2.2.2. Scope of enablement

Rejections withdrawn

Rejection of claim 37 was made in error and is withdrawn.

Rejection of claim 22, 23, 25 and 28 and 37 under 35 U.S.C. 112 is withdrawn because claim 22 has been amended.

3. Examiner's amendment

- a. Please cancel claims 35, 37 and 38.
- b. In claim 22 the fourth line, after --a fragment-- insert --thereof--;
in claim 25 in the second line, after --comprising-- insert --a-- and after
--fragment-- insert --of the--;
in claim 28 in the second line, replace --plus-- with --and--;
in claim 29, in the third line, after --a fragment-- insert --of the--.
- c. Please amend claims 36 to depend on claim 22.
- d. Amend claim 40 to read:

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40. An isolated recombinant polynucleotide molecule comprising nucleic acid [according to claim 35 plus] of SEQ ID NO: 4 and expression-controlling elements linked operably with said nucleic acid to drive expression thereon.

e. Amend claim 41 to read:

41. A mammalian, insect or bacterial host cell that has been genetically engineered by the insertion of nucleic [according to claim 35] which comprises SEQ ID NO:4. [codes for a protein fragment of the amino acid sequence of SEQ ID NO:3 which exhibits prolyl oligopeptidase activity.]

f. Amend claim 42 to read:

42. A process for producing a polypeptide [which includes a portion of SEQ ID NO:3] exhibiting prolyl oligopeptidase activity, which process comprises culturing the host cell of claim 41 under conditions sufficient for the production of said polypeptide.

g. Amend claim 43 to read:

43. [The] A purified polypeptide comprising the protein [portion] fragment of SEQ ID NO: 3 produced by the process of claim [40] 30.

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h. Please amend claims 44 to read:

44. A mammalian, insect or bacterial host cell which comprises an expression vector comprising the [nucleic acid of claim 35 encoding a polypeptide having the entire amino acid sequence set forth in SEQ ID NO: 3 operably linked to a promoter] polynucleotide of claim 40.

Authorization for this examiner's amendment was given in a telephone interview with James Schumann on August 3, 2004.

4. Allowance

Claims 22-31, 36 and 40-44 are allowed for reasons stated in the Office Action of June 9, 2004.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Malgorzata A. Walicka, Ph.D., whose telephone number is (571) 272-0944. The examiner can normally be reached Monday-Friday from 10:00 a.m. to 4:30 p.m.

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If attempts to reach examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, Ph.D. can be reached on (572) 272-0928.

The fax number for this Group is (571) 273-0937.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionists whose telephone number is (571) 273-0937.

Malgorzata A. Walicka, Ph.D.

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Patent Examiner

R. Achutamurthy
WILLIAM E. PATENT
PRINCIPAL EXAMINER
GROUP 1652
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